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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/819,209 | 03/28/2001 | Satoshi Kyotoku | B422-146 | 2354 |

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EXAMINER

PYZOCHA, MICHAEL J

ART UNIT PAPER NUMBER

2137

DATE MAILED: 03/07/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|------------------------|---------------------|--|
| Office Action Summary | Application No. | Applicant(s) | |
| | 09/819,209 | KYOTOKU, SATOSHI | |
| | Examiner | Art Unit | |
| | Michael Pyzocha | 2137 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 February 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5,7-11,13-17,27,28 and 34-39 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5,7-11,13-17,27,28 and 34-39 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>10012004, 10262004</u> | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

1. Claims 1-5, 7-11, 13-17, 27-28, 34-39 are pending.
2. Amendment filed 02/03/2005 has been received and considered.

Priority

3. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Specification

4. The specification is objected to under 37 CFR 1.75(d) for failing to failing to provide clear antecedent basis for the terms and phrases used in the claims. In particular, the specification fails to adequately link the corresponding structure, material, or acts in the specification with the particular means plus function limitations of claims 7-11, 27-28 and 38-39. Per MPEP 2181, the Applicants are required to either (a) state on the record or (b) amend the specification to state the corresponding structure, material or acts to perform the recited function. MPEP 2181, p. 2100-219 particularly the paragraph beginning at the bottom of column 1 and ending in column 2.

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Claim Rejections - 35 USC § 112

5. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

6. Claims 1-5, 7-11, 13-17, 27-28, 34-39 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for optically reading information on a part including information for positioning the part and terminating the software based on the information, does not reasonably provide enablement for terminating the software based on the positioning information for the part. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to use the invention commensurate in scope with these claims.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the

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differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

8. Claims 36 and 38 are rejected under 35 U.S.C. 103(a) as being unpatentable over Katsuhiko et al (JP 06-267809) and further in view of Isao et al (JP 06-036977).

As per claims 36 and 38, Katsuhiko et al discloses optically reading information on a part and terminating software based on the information (see Abstract and paragraph 24).

Katsuhiko et al fails to disclose the information on the part is for positioning the part.

However, Isao et al teaches a wafer having positioning information on it (see abstract).

At the time of the invention it would have been obvious to a person of ordinary skill in the art to use Isao et al's wafers in the wafer production of Katsuhiko et al.

Motivation to do so would have been to have the positioning information to align the wafer (see Isao et al Abstract).

9. Claims 1-5, 7-11, 13-17, 27-28, 34-35, 37 and 39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schneier et al further in view of Katsuhiko et al (JP 06-267809) and further in view of Isao et al (JP 06-036977).

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As per claims 1, 7, 13, Schneier et al discloses a detection step of detecting a location and a termination step of terminating the execution of software in accordance with the location (see column 14 lines 33-48).

Schneier et al fails to disclose a reading step of optically reading information on a part for positioning the part and terminating the software based on the information.

However, Katsuhiko et al teaches optically reading information on a part and terminating software based on the information (see Abstract and paragraph 24) and Isao et al teaches a wafer having positioning information on it (see abstract).

At the time of the invention it would have been obvious to a person of ordinary skill in the art to use Schneier et al's GPS controlled system to control the wafer production of Katsuhiko et al with the wafers of Isao et al.

Motivation to do so would have been to automatically process wafers (see Katsuhiko et al paragraph 24) and to have the positioning information to align the wafer (see Isao et al Abstract).

As per claims 2, 8 and 14 the modified Schneier et al, Katsuhiko et al and Isao et al system discloses at the termination step, the execution of said software is terminated

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at a location other than a predetermined location (see Schneier et al column 14 lines 33-48).

As per claims 3, 9, and 15, the modified Schneier et al, Katsuhiko et al and Isao et al system discloses at the detection step, a location is detected from a GPS signal received by a GPS receiver (see Schneier et al column 14 lines 33-48).

As per claims 4, 10, and 16, the modified Schneier et al, Katsuhiko et al and Isao et al system discloses the execution of software for controlling semiconductor manufacturing procedures is terminated (see Katsuhiko et al paragraph 24).

As per claims 5, 11, and 17, the modified Schneier et al, Katsuhiko et al and Isao et al system discloses the execution of remote access software is terminated (see Schneier et al column 14 lines 33-67).

As per claims 27-28, and 34-35, the modified Schneier et al, Katsuhiko et al and Isao et al system discloses a reading step of optically reading information on a part for positioning the part (as in rejection of claim 1); and a transmission step of transmitting the information to a remote access destination in order to notify that remote access is permitted (see Schneier et al column 14 lines 55-60 where the authorization information is read from the wafer of Katsuhiko) and transmitting a GPS signal (see Schneier et al column 14 lines 33-48).

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As per claims 37 and 39 the modified Schneier et al, Katsuhiko et al and Isao et al system discloses the limitations of claims 36 and 38 also including the location information as in claim 1.

10. Claims 1-5, 7-11, 13-17, 27-28, 34-35, 37 and 39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Olarig et al (US 6125446) further in view of Katsuhiko et al (JP 06-267809) and further in view of Isao et al (JP 06-036977).

As per claims 1, 7, 13, Olarig et al discloses a detection step of detecting a location and a termination step of terminating the execution of software in accordance with the location (see column 4 lines 31-45).

Olarig et al fails to disclose a reading step of optically reading information on a part for positioning the part and terminating the software based on the information.

However, Katsuhiko et al teaches optically reading information on a part and terminating software based on the information (see Abstract and paragraph 24) and Isao et al teaches a wafer having positioning information on it (see abstract).

At the time of the invention it would have been obvious to a person of ordinary skill in the art to use Olarig et al's GPS

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controlled system to control the wafer production of Katsuhiko et al with the wafers of Isao et al.

Motivation to do so would have been to automatically process wafers (see Katsuhiko et al paragraph 24) and to have the positioning information to align the wafer (see Isao et al Abstract).

As per claims 2, 8 and 14 the modified Olarig et al, Katsuhiko et al and Isao et al system discloses at the termination step, the execution of said software is terminated at a location other than a predetermined location (see Olarig et al column 4 lines 31-45).

As per claims 3, 9, and 15, the modified Olarig et al, Katsuhiko et al and Isao et al system discloses at the detection step, a location is detected from a GPS signal received by a GPS receiver (see Olarig et al column 4 lines 31-45).

As per claims 4, 10, and 16, the modified Olarig et al, Katsuhiko et al and Isao et al system discloses the execution of software for controlling semiconductor manufacturing procedures is terminated (see Katsuhiko et al paragraph 24).

As per claims 5, 11, and 17, the modified Olarig et al, Katsuhiko et al and Isao et al system discloses the execution of remote access software is terminated (see Olarig et al column 4 lines 31-45).

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As per claims 27-28, and 34-35, the modified Olarig et al, Katsuhiko et al and Isao et al system discloses a reading step of optically reading information on a part for positioning the part (as in rejection of claim 1); and a transmission step of transmitting the information to a remote access destination in order to notify that remote access is permitted (see Olarig et al column 4 lines 31-45) and transmitting a GPS signal (see Olarig et al column 14 lines 33-48).

As per claims 37 and 39 the modified Olarig et al, Katsuhiko et al and Isao et al system discloses the limitations of claims 36 and 38 also including the location information as in claim 1.

Response to Arguments

11. Applicant's arguments with respect to claims 1-5, 7-11, 13-17, 27-28, and 34-39 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Bush (US 5835377) discloses a method of remote manufacture with GPS.

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13. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Pyzocha whose telephone number is (571) 272-3875. The examiner can normally be reached on 7:00am - 4:30pm first Fridays of the bi-week off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Caldwell can be

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reached on (571) 272-3868. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

MJP



ANDREW CALDWELL
SUPERVISORY PATENT EXAMINER